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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,924	07/18/2000	Scott E. Lilienthal	SEL1	8587

7590 09/10/2004

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EXAMINER

KOVALICK, VINCENT E

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 09/10/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,924

Applicant(s)

LILIENTHAL, SCOTT E.

Examiner

Vincent E Kovalick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5, 8, 9, 12-15, 17, 18 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 18 and 20-24 is/are allowed.
- 6) ☒ Claim(s) 2-5, 8, 9, 12-15, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Applicant's Amendment dated March 19, 2003 in response to USPTO Office Action dated December 26, 2002.

The cancellation of claims 1, 7, 16 and 19, the addition of claims 22-26 have been noted and entered in the record.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 5, 8, 12, 22 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan (USP 5,761,485) taken with Naim (USP 6,694,200) in view of Simone (USP 4,997,374).

Relative to claims 22, Munyan **teaches** a personal electronic book system (col. 4, lines 34-67 and col. 5, lines 1-32); Munyan further **teaches** a portable paperless book comprising a visual display system, and an audible display system (col. 5, lines 47-65 and col. 15, lines 27-37), and wherein the visual information is a printed book with words electronically displayed on the visual display for reading and may be electronically erased from the visual display after the

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words are read, controls for the erasure of the visual display after the words are read (col. 5, lines 51-562).

Munyan **does not teach** a temporary storage site, a digital storage system for visual and audible information, and a power system containing a battery for powering the portable paperless book, and the audible information is electronically synthesized words of the printed book which are synthesized in synchrony with the words electronically displayed on the visual display, wherein the visible information may be read under constantly changing conditions when the conditions favor visible reading, and the audible information may be listened to under constantly changing conditions when the conditions favor listening to audible information.

Munyan teaches a personal electronic book system.

Naim **teaches** a hard disk based portable device (col. 1, lines 22-67 and col. 2, lines 1-67); Naim further **teaches** a temporary storage site, a digital storage system for visual and audible information, and a power system containing a battery for powering the portable paperless book (col. 2, lines 20-56; col. 4, lines 42-55 and Fig. 3A).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide to the device as taught by Munyan the feature as taught by Naim in order to provide a very large storage capacity of both video and audio data.

Munyan taken with Naim **does not teach** the portable paperless book wherein audible information is electronically synthesized words of the printed book which are synthesized in synchrony with the words electronically displayed on the visual display, wherein the visible information may be read under constantly changing conditions when the conditions favor visible

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reading, and the audible information may be listened to under constantly changing conditions when the conditions favor listening to audible information.

Munyan taken with Naim teaches a portable electronic book system with a large storage capacity.

Simone **teaches** a teaching device for assisting a child in learning to read (col. 1, lines 9-68 and col. 2, lines 1-50); Simone further **teaches** the portable paperless book wherein audible information is electronically synthesized words of the printed book which are synthesized in synchrony with the words electronically displayed on the visual display, wherein the visible information may be read under constantly changing conditions when the conditions favor visible reading, and the audible information may be listened to under constantly changing conditions when the conditions favor listening to audible information (col. 1, lines 53-63; col. 2, lines 5-18; col. 3, lines 63-67; col. 4, lines 1-5 and Fig. 2).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide to the device as taught by Munyan taken with Naim the feature as taught by Simone in order to provide means to correlate video and audio data and display visual images with related audio information.

Regarding claim 2, Simone further **teaches** paperless book wherein the display of visual information is a ferroelectric display, electroluminescent display, liquid crystal display, or light emitting diode (col. 3, lines 5-18 and col. 5, lines 49-63).

Relative to claims 5, Simone **teaches** said paperless book wherein the audible information display is produced by headphones, ear phones, speakers permanently attached to the paperless

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book, or speakers detachably attached to the paperless book (col. 3, lines 55-56 and Fig 1. item 28).

Relative to claim 8, Munyan taken with Naim in view of Simone **does not specifically teach** said paperless book comprising a switch which activates and deactivates the visual and audible displays; such features being in common practice in the operation of video and audio devices. Because such practice is well know and in common practice in the art it would have been obvious to a person of ordinary skill in the art at the time of the invention that ON/OFF switches would be an inherent item on the audio and video devices as taught by Munyan taken with Naim in view of Simone.

Regarding claim 12, Naim further **teaches** a paperless book wherein the digital storage device is a ROM selected from the group of ROM consisting of floppy disk, CD-ROM disk, and DVD disk (col. 4, lines 42-55).

Relative to claim 25, Munyan taken with Naim in view of Simone **does not teach** a portable paperless book wherein the constantly changing condition which favors visible reading is reading on a train, such features being in common practice in the viewing of visible reading material. Because such practice is well know and in common practice it would have been obvious to a person of ordinary skill in the art at the time of the invention that reading on a train lends itself to reading because the reader can dedicate his whole attention to the reading process.

Regarding claim 26, Munyan taken with Naim in view of Simone **does not teach** a portable paperless book wherein the constantly changing condition which favors listening to audible information is driving an automobile; such features being in common practice in the operation of audio devices.

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Because such practice is well known and in common practice in the art it would have been obvious to a person of ordinary skill in the art at the time of the invention that driving an automobile lends itself to listening to an audio presentation because the listener can listen while driving.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan taken with Naim in view of Simone as applied to claim 2 in item 3 hereinabove, and further in view of Fukumoto et al. (USP 6,380,923).

Regarding claim 3, Munyan taken with Naim in view of Simone **does not teach** said paperless book wherein the display of visual information is in a head-mounted display.

Munyan taken with Naim in view of Simone teaches a portable electronic book system with a large storage capacity.

Fukumoto et al. **teaches** a wearable information display device (col. 2, lines 15-67 and col. 3, lines 1-6); Fukumoto et al. further **teaches** said paperless book wherein the display of visual information is in a head-mounted display (col. 17, lines 50-55 and col. 19, lines 33-40).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide to the device as taught by Munyan taken with Naim in view of Simone the feature as taught by Fukumoto et al. in order to provide a hands free electronic book for adaptation in an environment where the user has a task requiring the use of his hands while observing a image on a display.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan taken with Naim in view of Simone as applied to claim 2 in item 3 hereinabove and further in view of Boulton (USP 4,985,697).

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Regarding claim 4, Munyan taken with Naim in view of Simone **does not teach** said paperless book wherein the display of visual information is in a screen on the paperless book.

Munyan taken with Naim in view of Simone teaches a portable electronic book system with a large storage capacity.

Boulton **teaches** an electronic book device related to methods for presenting educational training material (col. 2, lines 39-68, col.3, lines 1-67; col. 4, lines 1-54; Fig. 8 and Abstract); Boulton further teaches a paperless book wherein the display of visual information is in a screen on the paperless book (col. 9, lines 67-68 and col. 10, line 1).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide to the device as taught by Munyan taken with Naim in view of Simone the feature as taught by Boulton in order provide the means to display the visual information on the screen of a paperless book.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan taken with Naim in view of Simone as applied to claim 22 in item 3 hereinabove and further in view of Reavey et al. (USP 5,847,698).

Regarding claim 9, Munyan taken with Naim in view of Simone **does not teach** said paperless book comprising an electronic bookmark.

Munyan taken with Naim in view of Simone teaches a portable electronic book system with a large storage capacity.

Reavey et al. **teaches** an electronic book device (col. 2, lines 66-67; col. 3, lines 1-67 and col. 4, lines 1-11); Reavey further **teaches** said paperless book comprising an electronic bookmark (col. 7, lines 13-23 and col. 9, lines 5-6).

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide to the device as taught by Munyan taken with Naim in view of Simone the feature as taught by Reavey et al. add the realism of marking a page in the paperless the bookmark in the same manner as it accommodates marking a page in a paper book.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan taken with Naim in view of Simone as applied to claim 22 in item 3 hereinabove and further in view of McTaggart (USP 6,021,306).

Regarding claim 13, Munyan taken with Naim in view of Simone **does not teach** said paperless book wherein a highlighted portion of the text indicates an associated visual or audible file.

Munyan taken with Naim in view of Simone teaches a portable electronic book system with a large storage capacity.

McTaggart **teaches** an apparatus for enhancing the comprehension and retention of information displayed in a book by combining audio and/or visual messages with the presentation of printed material (col. 2, lines 35-67 and col. 3, lines 1-28); McTaggart further **teaches** said paperless book wherein a highlighted portion of the text indicates an associated visual or audible file (col. 2, lines 38-47).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide to the device as taught by Munyan taken with Naim in view of Simone the feature as taught by McTaggart in order to facilitate highlighting visual or printed matter in order to stress its meaning and improve comprehension and retention on the part of a reader.

8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan taken with Naim in view of Simone as applied to claim 22 in item 3 hereinabove and further in view of

Nobles et al. (USP 4,820,167).

Regarding claim 14, Munyan taken with Naim in view of Simone **does not teach** said paperless book comprising controls which control the speed at which the visual and audible information is scrolled.

Munyan taken with Naim in view of Simone teaches a portable electronic book system with a large storage capacity.

Nobles et al. **teaches** an electronic school teaching system (col. 1, lines 56-68; col. 2, lines 1-68; col. 3, lines 1-68 and col. 4, lines 1-25); Nobles et al. further teaches said paperless book comprising controls which control the speed at which the visual and audible information is scrolled (col. 5, lines 45-47).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide to the device as taught by Munyan taken with Naim in view of Simone the feature as taught by Nobles et al. in order to provide the means for a user to scroll information a speed suited to the user.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan taken with Naim in view of Simone as applied to claim 22 in item 3 hereinabove and further in view of Ohara et al. (USP 6,297,812).

Relative to claim 15, Munyan taken with Naim in view of Simone **does not teach** said paperless book comprising a control which determines at which point in the sequence of visual and audible information the process of displaying the visual and audible information will begin.

Munyan taken with Naim in view of Simone teaches a portable electronic book system with a large storage capacity.

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Ohara et al. **teaches** an information display system for electronically reading a book (col. 1, lines 57-67 and col. 1, lines 1-67); Ohara et al. further **teaches** said paperless book comprising a control which determines at which point in the sequence of visual and audible information the process of displaying the visual and audible information will begin (col. 4, lines 50-67).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to provide to the device as taught by Munyan taken with Naim in view of Simone the feature as taught by Ohara et al. in order to provide the means that will permit the user to determine at which point in the visual and audible information the display process will begin.

Allowable Subject Matter

10. Claims 17-18, 20-21 and 23-24 are allowed.

11. The following is an examiner's statement of reasons for allowance:

Relative to claims 23, the major difference between the teachings of the prior art of record (USP 5,761,485, Munyan; USP 6,694,200, Naim and USP 4,997,374, Simone) and that of the instant invention is that said prior art of record **does not teach** the process of displaying information in a portable paperless book comprising a visual display system, an audible display system, a digital storage system for visual and audible information, a temporary storage site, and a power system containing a battery for powering the portable paperless book, wherein the visual information is a printed book with words electronically displayed on the visual display for reading and may be electronically erased from the visual display after the words are read, controls for the erasure of the visual display after the words are read, and the audible information is electronically synthesized words of the printed book which are synthesized in synchrony with

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the words electronically displayed on the visual display, wherein the visible information may be read under constantly changing conditions when the conditions favor visible reading, and the audible information may be listened to under constantly changing conditions when the conditions favor listening to audible information comprising the steps: a. downloading visual and audible information from a digital storage device into the temporary storage site, b. displaying a page of printed words from the temporary storage site on a visual display, and c. displaying audible expression of the words of the page of printed words from the temporary storage site on an audible display, the display of audible material simultaneously with the display of words of the page of printed words.

Regarding claim 24 the major difference between the teachings of the prior said art of record and that of the instant invention is that said prior art of record **does not teach** a paperless book comprising: a housing, a central processing unit, ROM reader, permanent memory unit, and temporary memory unit mounted within the housing, a visual display, power jack, head-mounted visual display housing jack, audible display housing jack, scroll button, select button, play button, stop or pause button, directional control buttons, volume control dial, brightness control dial, door for inserting ROM, and shoulder strap, mounted on the housing, earphones, connecting wires, and an earphone jack, the earphone jack connected to the audible display Housing jack, a head-mounted visual display, connecting wire, and visual display jack, the visual display jack connected to the head-mounted visual display housing jack, and a battery for powering the paperless book, wherein audible information is electronically synthesized words of the printed book which are synthesized in synchrony with the words electronically displayed on the visual display, wherein the visible information may be read under constantly changing conditions when

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the conditions favor visible reading, and the audible information may be listened to under constantly changing conditions when the conditions favor listening to audible information.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent No.	6,384,808	Azami
U. S. Patent No.	6,243,071	Shwartz
U. S. Patent No.	5,893, 132	Huffman et al.
U. S. Patent No.	5,239,665	Tsuchiya
U.S. Patent No.	5,631,883	Li

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Responses


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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vincent E Kovalick whose telephone number is 703 306-3020. The examiner can normally be reached on Monday-Thursday 7:30- 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on 703 305-4938. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Vincent E. Kovalick
Aug. 25, 2004


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